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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,997

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Piero Andreas Madar

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EXAMINER

VAUGHAN, MICHAEL R

ART UNIT

PAPER NUMBER

2431

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,997	<b>Applicant(s)</b> MADAR ET AL.	
	<b>Examiner</b> MICHAEL R. VAUGHAN	<b>Art Unit</b> 2431	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **2/24/10** has been entered.

Claims 1-20 are pending. Claims 1, 4-5, 7-8, 11, 12, 15, 16, 19, and 20 have been amended.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 16 comprises digital storage medium. Digital storage medium includes signals. Signals are not a statutory class of invention. In order to overcome this interpretation, the claim should be amended to only

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include "non-transitory" digital storage medium. There is support for this amendment because the original disclosure does not preclude the non-transitory types of digital storage media.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 8, and 16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent Publication 2003-132624 to Tsurui in view of USP Application Publication 2002/0146238 to Sugahara.

As per claims 1 and 8, Tsurui teaches a method and a digital recording and playback apparatus comprising:

enabling a user to record digital signals onto a digital storage medium in a first program chain for password protection said first program chain being a single program chain according to DVD specifications (0030-0031);

receiving a password from said user for said selected recording title (0033);

storing said password on said digital storage medium (0051); and

requiring said password to be input before playing back said selected recording title (0030). Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030]. Therefore Tsurui is silent in disclosing storing both the selected recording title and the password in a single PGC. First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is that both the selected title (program number) and the password for that number are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. The claim is

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obvious because one of ordinary skill in the art can substitute known methods which produce predictable results. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC which its cells could store the password, the title, and even the password input menu if said password was for only said title.

As per claim 16, Tsurui teaches a digital storage medium, comprising:

a plurality of data fields [DVD standard] (0027); and

wherein said data fields comprise a first program chain [PCG#10] for storing a selected recording title and a user-assigned password for said selected recording title (0051) and program chain being according to DVD specification (0030).

Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030]. Therefore Tsurui is silent in disclosing storing both the selected recording title and the password in a single PGC. First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is

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that both the selected title (program number) and the password for that number are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. The claim is obvious because one of ordinary skill in the art can substitute known methods which produce predictable results. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC which its cells could store the password, the title, and even the password input menu if said password was for only said title.

As per claims 2, 9, and 17, Tsurui teaches the digital storage medium is a DVD (0030).

As per claims 3 and 10, Tsurui teaches the step of storing at least one command on said digital storage medium in said first program chain (0071).

As per claims 4 and 11, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040).

As per claims 5, 7, 12, 15, and 19, the combination of Tsuria and Sugahara essentially moves the password and the selected title into a single PGC. Tsuria had already taught that the menu which drives the password user input menu is in a second PGC (0035-36). It is well known in the art that a first PGC can branch to second PGC

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and then return to the first PGC once the second PGC concludes. Therefore it is obvious that the first PGC containing the password and title can first link to a second PGC which drives the user password input menu, stored the user input password, and return (post command) to the first PGC for password comparison. The claim is obvious because this is a predictable result from Tsuria and Sugahara as combined in the rejection of claim 1.

As per claim 6, Tsurui teaches wherein said at least one command includes a PRE command according to DVD specification (0041).

As per claim 13, Tsurui teaches at least one command includes a plurality of commands [chain leads to multiple other commands with there respective pre/post commands; 0042-0046].

As per claim 14, Tsurui a plurality of commands comprise PRE commands according to DVD specifications [chain leads to multiple other commands with there respective pre/post commands; 0042-0046].

As per claim 18, Tsurui teaches said first program chain also stores at least one command [PGC#10; 0046 and Figure 5b].

As per claim 20, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040) and input of said user-assigned password is required before playing back said selected recording title (0051).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/M. R. V./

Examiner, Art Unit 2431

/William R. Korzuch/

Supervisory Patent Examiner, Art Unit 2431